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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,648	01/07/2000	RONALD S. STEELMAN	54655USA1B/009	3344

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10/07/2002

OFFICE OF INTELLECTUAL PROPERTY COUNSEL  
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EXAMINER
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GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
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1733

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DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/479648

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 9 JULY 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 20-31, 34-42 and 45-66 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 29-31, 34-40 and 64 is/are allowed.
- ☒ Claim(s) 20-28, 41-42, 45-63 and 65-66 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 11
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. Before proceeding further, the following are noted:  
(a) The word "fail" in line 5 of paragraph 6 of the last Office action should read (and should have read) "is seen"; Examiner error - mea culpa; (b) the term "In the pertinent art of the present invention" at page 4 line 17 of applicants' specification is not understood in the context in which presented i.e. is apparently misplaced; and (c) a substitute specification was apparently submitted with the latest amendment, which substitute (1) was not requested or required by the Examiner; and (2) is apparently unnecessary.

2. Paragraph 1 of the last Office action is hereby reiterated; inserting the term "; a film having removable adhesive coated thereon may also be included" after "substrate" (and before the period) at page 8 line 31 of applicants' specification would effectively overcome this objection WHILE AT THE SAME TIME TAKE NOTHING AWAY FROM THE APPLICANTS AND/OR THEIR INTENT.

3. Claims 41-42, 45-56 and 62-63 are rejected under 35 U.S.C. § 112, first paragraph; this rejection is adhered to essentially for the reasons of record (see paragraph 4 of the last Office action), with the following being additionally advanced: (a) The entire tenor of applicants' specification (i.e. N.B. e.g. page 1 line 21, page 3 lines 18 and 30 and page 4 line 19) is seen to fairly and clearly indicate that applicants

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intended and envisioned inventive method is directed to and concerned with the application of adhesive films to IRREGULARLY surfaced substrates as opposed to the unspecified, unqualified and generalized "WALL" substrate as now claimed; and (b) claim 14 line 2 - the word "wall" should apparently read "side", consistent with applicants' specification at page 4 line 18 (and also page 3 line 27).

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20 and 22-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gladen.

6. Claims 57-61, 65-66, 21 and 24-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hargarter et al. in view of Gladen.

7. Applicants' arguments filed 9 July 2002 have been fully considered but they are not deemed to be persuasive. The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 6-7 of the last Office action),

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with the following being additionally advanced: In response to applicants' arguments and contentions made in the amendment at (a) page 4 line 4 thru page 6 line 3 (and especially page 4 lines 15-19, page 4 line 24 thru page 5 line 2, page 5 lines 3-10 and page 5 lines 17-24) (1) motivation and/or suggestion to modify the Gladen teaching is fairly and clearly set forth at lines 3-15 of paragraph 6 of the last Office action; (2) this (foregoing) modification of the Gladen teaching proposed by the Examiner is seen not to compromise the general principle set forth therein, which principle is to supply and apply sufficient heat and pressure to effect satisfactory lamination between the parts to be bonded; and (3) the "fine screen texture" provided for and imparted by the Teflon cloth of Gladen can hardly be equated with the "distortion, tearing or other such damage" referred to as being avoided by applicants' envisioned HNBS, this aforementioned texture being fairly and clearly disclosed by Gladen (N.B. column 2 lines 9-12) as being beneficial and advantageous; and (b) page 6 lines 6-24 (1) the pretreatments (e.g. corona discharge treatment) provided for by Hargarter et al. are fairly and clearly disclosed and indicated as being OPTIONAL (N.B. column 7 lines 45-47); and (2) it is reiterated (see paragraph 10 of the FIRST Office action mailed 17 July 2001) that the beneficial function and results (viz. non-stick pressure application, appealing and/or improved appearance etc.) deriving from and

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provided by the Teflon cloth pressure pad of Gladen would render its use in/in conjunction with the process of Hargarter et al. obvious to those of ordinary skill in this art.

8. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. In spite of the foregoing rejections, the Examiner continues to feel that there is patentable subject matter present in this application at this point in the prosecution, and therefore claims 29-31, 34-40 and 64 are indicated as being

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allowable, with the caveat that yet another updated search may uncover art more pertinent than that already of record.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) ~~305-3599~~ <sup>872-9311</sup>.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJGallagher:cdc

September 23, 2002

  
JOHN J. GALLAGHER  
PRIMARY EXAMINER  
ART UNIT 181,733